



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,266	06/27/2003	Brad R. Lewis	02-463-A	8325

7590 01/10/2007
Edward K. Runyan
McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Drive
Chicago, IL 60606

EXAMINER

AZAD, ABUL K

ART UNIT	PAPER NUMBER
----------	--------------

2626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/608,266

Applicant(s)

LEWIS ET AL.

Examiner

ABUL K. AZAD

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are pending in this Office Action.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-22 of copending Application No. 10/519,274. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5,757,908) in view of Fitzpatrick et al. (US 2002/0184033).

As per claim 1, Richardson teaches, "a method of modifying a diagnostic device", the method comprising:

"receiving, from a user, product-identifying information for the diagnostic device" (Fig. 2, elements B and B1);

"transmitting a software key that corresponds to the product-identifying information and software key to be spoken to the user" (Fig. 2, element "user given Registration No." and col. 7, lines 36-50).

Richardson does not explicitly teach, "a text-to-speech server and performing a text-to-speech conversion". However, Fitzpatrick teaches, "a text-to-speech server and performing a text-to-speech conversion" (paragraph 0173). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a text-to-speech server because Fitzpatrick teaches his invention uses VXML to provide plentiful, inexpensive and powerful web application development tools (paragraph 0174).

As per claim 2, Richardson teaches, "entering the software key into the diagnostic device, and wherein modifying the diagnostic device comprises unlocking at least one feature in response to the software key being entered" (Fig. 2C).

As per claim 3, Richardson teaches, "entering the software key into the diagnostic device, and wherein modifying the diagnostic device comprises enabling a software update in response to the software key being entered" (Fig. 2C).

As per claim 4, Richardson teaches, "receiving, from the user, payment information" (Fig. 2, element C).

As per claim 5, Cooper teaches, "wherein the payment information comprises credit card information" (Fig. 2, element C).

As per claim 6, Richardson teaches, "receiving, from the user, feature-identifying information corresponding to the feature to be unlocked".

As per claim 7, Richardson teaches, "wherein the product-identifying information comprises a serial number" (Fig. 2b, element "Serial No.).

As per claim 8, Richardson does not explicitly teach, "a text-to-speech server in VXML format". However, Fitzpatrick teaches, "a text-to-speech server in VXML format" (paragraphs 0170-0173). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a text-to-speech server because Fitzpatrick teaches his invention uses VXML to provide plentiful, inexpensive and powerful web application development tools (paragraph 0174).

As per claim 9, Richardson teaches, "wherein the software key is transmitted via the internet" (col. 7, lines 33-35).

As per claim 10, Richardson teaches, "transmitting a prompt to the user requesting the user to specify a diagnostic device type" (Fig. 2, element B).

As per claim 11, Richardson teaches, "indicating to the user that a feature of the diagnostic device must be unlocked before it can be used" (col. 6, lines 42-67).

As per claim 12, Richardson teaches, "wherein the product-identifying information is a DTMF signal" (col. 7, lines 33-35).

As per claim 13, Richardson teaches, "wherein the product-identifying information comprises a set of spoken characters" (col. 7, lines 33-35).

As per claims 14-22, they are interpreted and thus rejected for the same reasons set forth in the rejection of claims 1-13.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abul K. Azad** whose telephone number is **(571) 272-7599**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richemond Dorvil**, can be reached at **(571) 272-7602**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

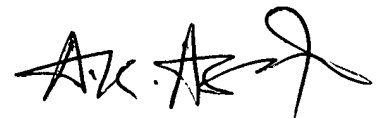
Alexandria, VA 22313-1450

Or faxed to: **(571) 273-8300**.

Hand-delivered responses should be brought to **401 Dulany Street, Alexandria, VA-22314** (Customer Service Window).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 5, 2007

A handwritten signature in black ink, appearing to read 'A.K. Azad', with a stylized flourish at the end.

Abul K. Azad
Primary Examiner
Art Unit 2626